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09/708,913	11/07/2000	J. P. Leon	00696-02500US	2660

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EXAMINER
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COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/708,913

Applicant(s)

LEON, J. P.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-65 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/7/00 & 12/22/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. Applicant should note the changes to patent practice and procedure:
    - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
    - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
    - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
  2. The proposed drawing correction filed 22 December 2003 has been approved.
  3. The substitute specification has been accepted and is the official specification for the instant case file. It is noted that applicant fails to make the require statement that the substitute specification does not contain any new matter.
  4. The disclosure is objected to because of the following informalities:
    - A) applicant must update:
      - (1) the application data on page(s) 1-2, 11, 13, 14 & 15, with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, --which is expired--, etc. In this regard note that the records of the Paten Office indicated that application 09/358,801 is now U.S. Patent No. 6,701,304 and that applications 09/708,698 and 09/611,375 are abandoned.
    - B) at line 17 of claim 13, the phrase "first eb server" should be -first web server--.
- Appropriate correction is required.
5. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

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6. Claims 1-10 & 12-55 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.1 In regard to claims 1-10 & 12-55, although on of ordinary skill at the time of the invention would know how to accomplish each of the individual recited actions/functions from the language of these claims, since, there is no clear and definite interconnection between one or more of the recited limitations of these claims, one of ordinary skill could not determine from the language of these claims whether or not they are in fact making and/or using the claimed invention. In this regard it is noted that from the language of these claims it is vague, indefinite and unclear:

A) in regard to claim 1, who or what accesses and from where:

(1) the first web server is accessed by communication first HTML content;

(2) receives the second HTML content from the first web server;

(3) detects the third HTML content indicating an user's input; and

(4) sends fourth HTML content to the first web server and receives information for printing an indicia from a second web server through the first web server using SSL communications;

since as recited in this claim the source of the access, the receiving and displaying or the detecting could be from anywhere other than the location that the HTML is displayed or the user's input is detected or the received indicia information is to be printed.

B) in regard to claim 1, where the first web server is located relative to the second web server, since as recited in this claim the these devices may be collocated and hence the same system or remote from one another and hence not the same system.

C) in regard to claim 13, who or what accesses and from where:

(1) the first web server is accessed by communication first HTML content;

(2) receives the second HTML content from the first web server;

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(3) detects the third HTML content indicating an user's input; and

(4) sends fourth HTML content to the first web server and receives information for printing an indicia from a second server through the first web server using SSL communications;

since as recited in this claim the source of the access, the receiving and displaying or the detecting could be from anywhere other than the location that the HTML is displayed or the user's input is detected or the received indicia information is to be printed.

D) in regard to claim 13, where the first web server is located relative to the second server, since as recited in this claim the these devices may be collocated and hence the same system or remote from one another and hence not the same system.

E) in regard to claims 23 & 42, who or what accesses and from where:

(1) the first server is accessed by communication first HTML content for a number of users;

(2) uses SSL communications to exchange information between a first and second server;

(3) receives printing information from the second server; and

(4) sends second HTML content containing the printing information to the users;

since as recited in this claim the source of the access could be from anywhere other than the location that the indicia information is sent.

F) in regard to claims 23 & 42, where the second web server is located relative to the first server, since as recited in this claim the these devices may be collocated and hence the same system or remote from one another and hence not the same system.

G) in regard to claim 32, who or what accesses and from where:

(1) the first server is accessed by communication first HTML content for a number of users;

(2) uses SSL communications to exchange information between a first and second server;

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(3) receives printing information from the second server; and

(4) sends second HTML content containing the printing information to the users;

since as recited in this claim the source of the access could be from anywhere other than the location that the indicia information is sent.

H) in regard to claim 32, where the second web server is located relative to the first server, since as recited in this claim the these devices may be collocated and hence the same system or remote from one another and hence not the same system.

6.2 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

7. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

7.1 Claims 1-10 & 12-65 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

7.1.1 The instant claims recite a system, (claims 56-65), and a method comprising a series of steps to be performed on a computer/server, (claims 1-10, 12, 23-31 & 42-55), and a manufacture comprising program code to be executed by a computer, (claims 13-22 & 32-41), which have a disclosed practical application in the technological or useful arts. Further, the instant claims do not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon.

7.1.2 In regard to claims 1-10 & 12-65, the invention as set forth in these claims merely describes:

A) in regard to claims 1-10, 12, 23-31 & 42-55, a method that receives information, processes the received information to generate indicia information that is not printed or used by the claimed process/method.

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B) in regard to claims 13-22 & 32-41, a manufacture containing code to receive information, process the received information to generate indicia information that is not printed or used by the claimed process/method, where a physical device is not required to execute the claimed code.

C) in regard to claims 56-65, a machine that receives information, processes the received information to generate indicia information that is not printed or used by the claimed machine.

However, the process/system/manufacture as recited in these claims does not apply the result of either the claim as a whole or the manipulations of data as recited in these claims in such a manner so as to be tangibly used in a concrete manner and hence to produce a useful concrete and tangible result, that is a concrete and tangible application with in the technological or useful arts.

7.1.3 It is further noted that applicant has not recited in these claims a specific process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, which is either:

- A) altered or changed or modified by the invention recited in claims; or
- B) utilizes the result of the invention recited in these claims; or
- C) is operated or controlled by the result of the invention recited in these claims.

7.1.4 It is further noted in regard to claims 1-10 & 12-65, that as claimed applicant has not claimed:

A) pre computer processing, since the claims fail to recited that the data, which originates from an unknown source, is manipulated or transformed/changed before it is processed; or

B) post computer processing, since the claims fail to recited that the data which represents the result of the claimed manipulation, is neither manipulated nor used nor changed by any device after it has been processed; or

C) a practical use of the claimed invention by any physical system or device or method outside of a statement of the intended use of the claimed invention; or

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D) process steps or physical acts/operations that would affect the internal operation of a computer/machine as were found to be statutory in either In re McIlroy 170 USPQ 31 (CCPA, 1971) or In re Waldbaum 173 USPQ 430 (CCPA, 1972); or

E) process steps or physical acts/operations that would be considered as going beyond the manipulation of “abstract ideas” as were found to be non-statutory in In re Warmerdam 31 USPQ2d 1754 (CAFC, 1994); or

F) a concrete and tangible practical application of either:

(1) the invention as a whole; or

(2) the final results of the manipulations/actions with in the technological or useful arts;

note In re Sarkar 200 USPQ 132 (CCPA, 1978) where the process step of “constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model” was held to be so tenuous connected to the remaining process steps as to not be a process with in the scope of 35 U.S.C. § 101.

Hence, the invention of claims 1-10 & 12-65 is merely directed to an hypothetical mental exercise that manipulates an abstract idea of a method/manufacture/machine that merely receives/exchanges and processes information to generate different information that is not applied or used by the claimed process/manufacture/machine and hence, is with out a claimed concrete and tangible practical application of the abstract idea, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578; and State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)).

7.1.5 It is further noted that the type/nature of either the data or the calculated numbers does not affect the operation of the claimed invention and hence are considered to be non function descriptive material, (note In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)).

7.1.6 In practical terms, claims define nonstatutory processes if they:

A) consist solely of mathematical operations without some claimed practical application (i.e., executing a “mathematical algorithm”); or



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B) simply manipulate abstract ideas, e.g., a bid (Schrader, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759),

without some claimed practical application of the mathematics or abstract idea.

7.1.7 In view of the above analysis claims 1-10 & 12-65, as a whole, are directed to an hypothetical mental exercise that merely manipulates mathematics or an abstract idea without a claimed concrete and tangible practical application of the mathematics or abstract idea, and hence are directed to non-statutory subject matter.

7.2 Claims 13-22 & 32-41 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

7.2.1 The instant claims recite a system/device/manufacture, (claims 13-22 & 32-41), which has a disclosed practical application in the technological or useful arts, and which does not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon. Hence, the instant claims merely define device/manufacture that contains a data structure comprising series of steps or acts or functions or operations that as claimed could be but are not necessarily to be performed by a computer.

7.2.2 It is further noted that applicant has not recited a specific machine since the steps or acts or functions or operations recited in the claim are merely to illustrate the steps or acts or functions or operations of the instant invention since these steps or acts or functions or operations as claimed are not in fact implemented by a processor/computer. Hence, applicant envisions the invention as recited in claims 13-22 & 32-41 as a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure. Such a disembodied storage device is not a specific machine because:

A) it is not associated with a computer in such a way as to cause the computer to operate in a specific manner, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578); and

B) a memory device alone can not perform the functions recited within the claims.

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Therefore, the recited disembodied storage device, which itself can not perform the functions recited within the claims as the invention, is inoperative and lacks utility for the purpose of the invention.

7.2.3 In view of the above, the invention recited in claims 13-22 & 32-41, merely describes an abstract idea of a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure, since a disembodied storage device by itself can not produce a concrete and tangible result by performing the functions recited within the claims as the invention (State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)). Hence, claim 13-22 & 32-41 do not have a claimed practical application, since the disembodied storage device is inoperative and therefore lacks utility for the purpose of the invention.

7.2.4 Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium;
- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

7.2.5 Hence, claims 13-22 & 32-41 are directed to non-statutory subject matter.

7.3 Claims 1-10 & 12-55 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

7.3.1 As set forth by the Court in:

A) In re Musgrave 167 USPQ 280 at 289-290 (CCPA 1970), “We cannot agree with the Board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all of the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the process to think. All that is necessary, in our view, to make a sequence of operational steps a statutory “process” within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of “useful arts.” Cons. Art. 1, sec. 8.”, {emphasis added}; and

B) In re Sarkar 100 USPQ 132 @ 136-137 (CCPA 1978), echoing the Board of Appeals stated in regard to claim 14 “14. A method of locating an obstruction in an open channel to affect flow in a predetermined manner comprising:

a) obtaining the dimensions of said obstruction which affect the parameters of flow;

b) constructing a mathematical model of at least that portion of the open channel in which said obstruction is to be located in accordance with the method of claim 1 using those dimensions obtained in step (a) above;

c) adjusting the location of said obstruction within said mathematical model until the desired effect upon flow is obtained in said model; and thereafter

d) constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model.”;

and “Concerning claims 14-39 and the significance of “post-solution activity,” like building a bridge or dam, the board concluded: While it is true that the final step in each of these claims makes reference to the mathematical result achieved by performing the prior recited steps, we consider the connection to be so

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tenuous that the several steps recited in each claim when considered as a whole do not constitute a proper method under the statute.", {emphasis added}.

7.3.2 Further, it is noted in regard to claims 14-39 of Sarkar, although step (d) of claim 14 of Sarkar references the result of step (c) of claim 14 of Sarkar it is clear from the language of step (c) of claim 14 of Sarkar that multiple adjustments to the location of the obstruction are required to be made until a location with the desired effect has been determined. Hence, the reference to constructing the obstruction at the "specified adjusted location" in step (d) of claim 14 of Sarkar is vague, indefinite and unclear in regard to which one of the possible multiple adjusted locations of the obstruction that were used during step (c) of claim 14 of Sarkar would be used when constructing the obstruction as required by step (d) of Sarkar. Therefore, without a clear connection between step (d) of Sarkar and the remaining steps of claim 14 of Sarkar, the Board of Appeals and the Court held that these claims were not a process within the meaning of process as used in 35 U.S.C. § 101 and hence were directed to non-statutory subject matter.

7.3.3 As can be seen from claims 1-10, 12, 23-31 & 42-55, these claims are directed to a series of process steps/actions/functions, which as set forth above in regard to the rejection of claims 1-10, 12, 23-31 & 42-55 under 35 U.S.C. § 112 2<sup>nd</sup> paragraph, are not clearly and definitely interconnected to one another and therefore do not provide an operative useful manufacture or method/process within the meaning of machine or process as used in 35 U.S.C. § 101.

7.3.4 Further on regard to the computer useable/readable medium of claims 13-22 & 32-41, the recited limitations are not clearly and definitely interconnected to one another and a device to execute the program code/instructions on the media so as to provide a useful operative and useful manufacture within the meaning of machine or process as used in 35 U.S.C. § 101.

7.5 Claims 1-10 & 12-55 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since:

A) in regard to claims 1-10 & 12-55, these claims fail to comply with the "requirements of this title, namely 35 U.S.C. § 112 2<sup>nd</sup> paragraph as set forth above.

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B) in regard to claims 1-10, 12-29, 31-39, 40-63 & 65, these claims fail to comply with the “requirements this title, namely 35 U.S.C. § 102 as set forth below.

C) in regard to claims 30, 40 & 64, these claims fail to comply with the “requirements this title, namely 35 U.S.C. § 103 as set forth below.

8. In regard to the flowing rejections based on the prior art:

A) it is respectfully noted that the function provided by hyper text is to either:

(1) transfer the user from one point on a network to another point on the network; or

(2) to retrieve additional information from the network;

hence, one of ordinary skill at the time the invention was made would have recognized the function of hypertext or HTTP or HTML as functionally equivalent to a function call or a request from one system to an other system.

B) it is respectfully noted that the function provided by web is a communications network between one point on a network to another point on the network, where a server controls access to a point in the network, hence, one of ordinary skill at the time the invention was made would have recognized that the restricted access to postage metering functions of the prior art as functionally equivalent to the claimed server, note the definition of a “server” found on page 355 of “Microsoft Press® Computer Dictionary” Second edition, 1994, Microsoft Press A Division of Microsoft Corp. One Microsoft Way Redmond, Washington 98052-6399, (discussed during the interview of November 13, 2003).

C) it is respectfully noted that in regard to the use of either HTML or SSL when communicating between various computers/systems:

(1) as would be readily recognized by one of ordinary skill in the art at the time of the invention a suitable communications protocol/procedure must be used for any two or more systems/computers to communicate with each other so that that each of the communicating systems would properly interpret any messages that are exchanged as well as the content of the exchanged messages,

hence the systems of the applied prior art would inherently use such a communications protocol/procedure when exchanging information/data.

(2) since the instant claims fail to recite a limitation that includes a recitation of the particular operation/function of either HTML or SSL that would affect how the claimed method/manufacture/system would operate other than that fact that HTML and SSL are used, the references to either HTML or SSL are deemed to be nonfunctional descriptive material. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium;

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9.1 Claims 1-10, 12-29, 31-39, 40-63 & 65 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Shah et al (5,822,738).

9.1.1 In regard to claims 1-3, 8-10, 12-15, 20-26, 28, 32-36, 38, 42-49, 51, 52, 54, 56-58, 60-63 & 65, Shah et al ('738) discloses that an user at system (20,430,480(1),480(N): figs. 6,7) after obtaining all of the necessary information for a postage indicia formulates a request for postage and sends the request via a communications link to proxy computer (120,410: figs. 6,7). Proxy computer, which can not dispense postage, passes the request for postage to SMD (210,400: figs. 6,7). SMD (210,400), which is licensed to dispense postage by an associated carrier, for example the United States Postal Service (USPS), once the request has been validated creates a complete postage indicia based on the request. Next SMD (210,400) sends the postage indicia back through the proxy computer (120,410) to the user's system (20,430,480(1),480(N)). Finally the user may print the postage indicia on an item of mail.

9.1.2 In regard to claims 4, 16, 31 & 41, since the postage dispensing system of Shah et al ('738) is implemented using a number of computers which require an operating program to control the operation of the system, the system of Shah et al ('738) inherently contains a number of software components.

9.1.3 In regard to claims 5, 6, 17 & 18, since the postage dispensing system of Shah et al ('738) is implemented using a number of computers which will automatically print the postage indicia, the system of Shah et al ('738) inherently prints the indicia with or without human intervention.

9.1.4 In regard to claims 7, 19, 27, 37, 53 & 59, since the postage dispensing system of Shah et al ('738) is implemented using a number of computers that use standard printers and not a photographic reproduction process, the system of Shah et al ('738) inherently contains a bit-

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map of the indicia in order to properly control the standard printer to accurately reproduce the indicia.

9.1.5 In regard to claims 9, 10, 29, 39, 50 & 55, since the postage dispensing system of Shah et al ('738) uses an indicia that is combination of fixed or background information and variable information, e.g. the date, postage, and verification data, the system of Shah et al ('738) inherently combines these two sources of information to complete the postage indicia.

9.2 Claims 1-10, 12-29, 31-39, 40-63 & 65 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either Carroll et al (6,470,327) or Bator et al (6,619,544).

9.2.1 In regard to claims 1-3, 8-10, 12-15, 20-26, 28, 32-36, 38, 42-49, 51, 52, 54, 56-58, 60-63 & 65, either Carroll et al ('327) or Bator et al ('544) disclose that an user at a client system, after obtaining all of the necessary information for a postage indicia, formulates a request for postage and sends the request via a communications link to a postage metering system/server. Postage metering system includes a SMD, which is licensed to dispense postage by an associated carrier, for example the Unites States Postal Service (USPS), once the request has been validated creates a completer postage indicia based on the request. Next the SMD sends the postage indicia back through the postage metering system to the user's system. Finally the user may print the postage indicia on an item of mail.

9.2.2 In regard to claims 4, 16, 31 & 41, since the postage dispensing systems of either Carroll et al ('327) or Bator et al ('544) are implemented using a number of computers which require an operating program to control the operation of the system, the systems of either Carroll et al ('327) or Bator et al ('544) inherently contains a number of software components.

9.2.3 In regard to claims 5, 6, 17 & 18, since the postage dispensing systems of either Carroll et al ('327) or Bator et al ('544) are implemented using a number of computers which will automatically print the postage indicia, the systems of either Carroll et al ('327) or Bator et al ('544) inherently prints the indicia with or without human intervention.

9.2.4 In regard to claims 7, 19, 27, 37, 53 & 59, since the postage dispensing system of either Carroll et al ('327) or Bator et al ('544) are implemented using a number of computers that use standard printers and not a photographic reproduction process, the systems of either



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Carroll et al ('327) or Bator et al ('544) inherently contains a bit-map of the indicia in order to properly control the standard printer to accurately reproduce the indicia.

9.2.5 In regard to claims 9, 10, 29, 39, 50 & 55, since the postage dispensing systems of either Carroll et al ('327) or Bator et al ('544) uses an indicia that is combination of fixed or background information and variable information, e.g. the date, postage, and verification data, the systems of either Carroll et al ('327) or Bator et al ('544) inherently combines these two sources of information to complete the postage indicia.

10. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

10.1 Claims 30, 40 & 64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Shah et al (5,822,738) or Carroll et al (6,470,327) or Bator et al (6,619,544) as applied above to claims 1-10, 12-29, 31-39, 40-63 & 65 in view of an inherent necessity.

10.1.1 In regard to claims 30, 40 & 64, either Shah et al ('738) or either Carroll et al ('327) or Bator et al ('544) does not disclose using the XML communications protocol, however, Shah et al ('738) does disclose the use of a protocol which will support the required communications between the various components of the system, therefore it would have been obvious to one of ordinary skill at the time the invention was made that the systems of either Shah et al ('738) or either Carroll et al ('327) or Bator et al ('544) could be modified to use any suitable

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communications protocol that would support the communications requirements of the systems of either Shah et al ('738) or either Carroll et al ('327) or Bator et al ('544) in order to accomplish the proper operation of the systems of either Shah et al ('738) or either Carroll et al ('327) or Bator et al ('544).

11. Response to applicant's arguments.

11.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

11.2 As per the 35 U.S.C. § 102 & 35 U.S.C. § 103 rejections, merely calling an item something with out attributing specific functions to it that would clearly distinguish it from any other device that would be recognized as performing the same function does not provide functional descriptive material on which a patentable distinction may be based. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

Hence, applicant's arguments are non persuasive.

12. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John

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Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

13.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

13.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

13.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

12/02/04



Edward R. Cosimano  
Primary Examiner A.U. 3629